

Remarks

I. SUMMARY

Claims 1-3, 7-8, and 21-29 are pending in the present application. Claims 4-6 and 9-20 are canceled herein without prejudice or disclaimer. Some of the canceled claims are drawn to non-elected embodiments, and some are rewritten as new claims for clarity. Applicants expressly reserve the right to file one or more divisional and/or continuation applications to prosecute the canceled claims without prejudice.

New claims 21-29 are added herein. Support for these new claims can be found in the specification, original claims, and/or figures. Accordingly, it is believed that no new matter has been introduced. Claims 1-3, 7-8 and 21-26 are directed to compositions for treating osteoporosis, and dependent claims 27-29 are directed to methods for treating osteoporosis by administering such compositions.

Claims 1-5 were rejected in the June 5, 2006 Office Action.

II. REJECTION UNDER 35 U.S.C. §101

Claims 1-3 stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Without agreeing with the merits of the rejection, to expedite prosecution, Applicants amend claim 1 herein to correct claim language informalities and to better present the invention. No new matter has been introduced. The claim amendment is believed to overcome the 35 U.S.C. §101 rejection and withdrawal of the rejection is respectfully requested.

II. REJECTION UNDER 35 U.S.C. §112

Claim 1-5 stand rejected under 35 U.S.C. §112, as allegedly being indefinite.

Claim 1 is amended herein. In particular, the term “the processed product” has been deleted (the subject matter of processed products is being pursued in new independent claim 21 and claims dependent therefrom), and the term “the effective ingredient” is replaced with “an effective ingredient.”

Claims 2 and 3 are also amended herein to put the claims in better U.S. claim format. Claims 4 and 5 are canceled in favor of new claims 21 and 22.

No new matter is believed to be introduced by these amendments. Applicants submit that the present claim amendments overcome the 35 U.S.C. §112 rejection and withdrawal of the rejection is requested.

III. REJECTION UNDER 35 U.S.C. §102(b)

Claims 1-5 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Koh *et al.* Applicants respectfully traverse this rejection and request withdrawal thereof in view of the present claim amendments and the following remarks.

The claims are amended herein to better reflect Applicants' compositions, and in particular, the various products produced during Applicants' process. Applicants respectfully submit that Koh neither teaches nor suggests the presently claimed invention. The Action asserts that the solvent used in the making of the *Cordyceps sinensis* extract is the same as disclosed in the claimed invention (see Page 4, Office Action). Applicants respectfully disagree. Koh discloses fractionation in ethyl acetate, followed by fractionation in methanol and extraction in water. Koh neither teaches nor suggests the use of other solvents, such as the presently claimed diethyl ether (see claim 21 and claims dependent therefrom) in extracting *Cordyceps sinensis*, nor does Koh teach or suggest products that result from extraction using other solvents. In fact, according to Koh, its resulting ethyl acetate-methanol-water extract is characterized by its constituents containing 83.9% carbohydrate, 11.8% protein, 1.9% lipid and 2.4% ash (see Abstract of Koh).

In contrast, the present invention is directed to a composition prepared by extracting a culture of *Cordyceps sinensis* using diethyl ether, followed by methanol and water extraction. Applicants respectfully submit that the extracts obtained at various stages of the present method, and in particular, the final water extract (which is the presently elected extract) is different from that of Koh. Because Koh does not teach or suggest the presently claimed compositions, nor does it teach or suggest the presently claimed methods of treatment using such products, Applicants submit that Koh does not anticipate the present invention.

Applicants submit herewith a Declaration under 37 C.F.R. §1.132 in support of this paper, which further demonstrates that the water extract obtained by the present method is different from that of Koh, and thus, Koh does not inherently anticipate the present compositions. In the Declaration, Applicants prepared water extracts using a diethyl ether solvent (according to the present method) and using ethylacetate (as in Koh). Both extracts were analyzed by nucleoside HPLC, GPC HPLC and protein, carbohydrate, lipid, ash and reduced sugar determination. The detailed experimental procedure is set forth in the Declaration. Water extract prepared according to the present invention is denoted as "WE-sb" and water extract prepared using ethylacetate (Koh) is denoted as "WE-koh". As set forth in the Declaration, *e.g.*, in the content percentage table (where WE-sb has a lower protein content, but higher carbohydrate content as compared to WE-koh), and in the profiles of nucleoside HPLC and GPC HPLC (having differing peaks indicated by slashes above the peaks), the content of the water extract of the present invention is different from that of Koh.

Because Koh fails to teach or suggest the presently claimed extract compositions and the claimed methods of their use, Applicants respectfully submit that Koh does not inherently anticipate the amended claims. The 35 U.S.C. §102(b) rejection is believed to be overcome by the present amendments, arguments and Declaration, and withdrawal of the rejection is respectfully requested.

IV. CONCLUSION

In view of the amendments to the claims and the arguments presented, Applicants respectfully submit that the present claims are patentable in view of the cited reference, and therefore are in condition for allowance. Therefore, Applicants respectfully request withdrawal of each rejection and allowance of the present application.

Applicants hereby petition for a one month extension of time. If additional extensions of time are necessary to prevent abandonment of this application, then extensions of time are hereby petitioned for under 37 C.F.R. §1.136(a), and any fees required, including fees for net addition of claims, are hereby authorized to be charged to account number 50-3120.

Should the Examiner believe that further discussion of any remaining issues would advance the prosecution, she is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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